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Attorney's Docket #: 00537-183002 / BPC 076

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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AUG 08 2002

Applicant : POLY-MED, INC.

Art Unit : 1619

Serial No. : 09/762,431

Examiner : A. Berman

Filed : February 7, 2001

TECH CENTER 1600/2900

Title : PHOSPHORYLATED POLYMERS AND CONJUGATES THEREOF

Commissioner for Patents  
Washington, D.C. 20231

RESPONSE TO RESTRICTION REQUIREMENT

Responsive to the action mailed January 28, 2002 (the "Action"), Applicants respectfully request consideration of the following remarks and reconsideration of the restriction delineated in the Action.

The instant application is a national stage application under 35 U.S.C. 371 of PCT International Application PCT/US99/18146. As such, unity of invention, rather than restriction, practice is applicable. See MPEP 1893.03(d). Rule 13 (Unity of Invention) of the Regulations under the PCT state that the requirement of unity is fulfilled when "there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features." Rule 13.2, Regulations under the PCT. Unity of Invention practice is also governed by MPEP 1893.03(d), which states in part:

*When making a lack of unity of invention requirement, the examiner **must** (1) list the different groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group.*

(Emphasis added) MPEP 1893.03(d).

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, Washington, D.C. 20231.

Date of Deposit

July 29, 2002

Signature

Maria Keen  
Maria Keen

Typed or Printed Name of Person Signing Certificate

While understanding that the Unity of Invention determinations made for the Preliminary Search Report and the Preliminary Examination Report are not binding, and that Unity of Invention is determined under the auspices of PCT Rule 13, Applicants note that the current restriction now alleges that the instant application contains almost three times the number of invention groups as determined in previous examination (i.e., 6 v. 17 groups).

Other than citation of U.S. Patent 5,079,337 (the " '377 Patent") (which was also considered at the Preliminary Search and Preliminary Examination stages), no indication is given as to the reasoning behind the allegation of lack of unity of each group with the others of Groups I to XVII. Such reasoning, as stated above, is required under MPEP 1893.03(d). No additional art is cited in support of creation of the alleged restriction groups. Applicants note that it is stated in the Action that the '377 Patent relates to dextran, a polysaccharide. Even assuming this to be the case, such interpretation merely provides a basis for distinguishing polysaccharide compositions from other polymeric materials (e.g., polyesters). No other rationale is provided for delineation of the multitude of restriction groups.

Groups I to IV, VII, and VIII are drawn to a single general inventive concept. These groups all relate to polyester compositions.

Groups V, VI, IX, XV, and XVII are drawn to a single general inventive concept. These groups all relate to polysaccharide compositions.

Group XI, XII, XIV, XVI and are drawn to a single general inventive concept. These groups all relate to methods of making phosphorylated polysaccharide compositions.

Group X is drawn to a single general inventive concept. This group relates to a method of making a polyester.

Group XIII is drawn to a single general inventive concept. This group relates to a method of making a phosphorylated microparticle.

Applicants submit that each of the combinations of groups stated above, respectively, meet the criterion of relating to a single inventive concept. Each combination of groups has a technical relationship that involves at least one common or corresponding technical feature. Such features define the contribution, considered as a whole, that the invention makes over the prior art.

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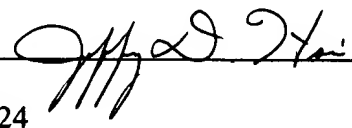
For the foregoing reasons, Applicants submit that the restriction made in the Action was improper and respectfully request reconsideration of that restriction and a delineation of reasoned support for distinguishing each group ultimately determined as lacking unity with each other group, as required under MPEP 1893.03(d).

In compliance with 37 C.F.R. 1.143, Applicants elect the invention of Group I drawn to a polyester, and elect the species tartaric acid (the monomer of claim 11). The election is made with traverse.

Please apply any charges or credits to Deposit Account No. 06-1050, referencing attorney docket number 00537-183002.

Respectfully submitted,

Date: July 29, 2002

  
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